

REMARKS/ARGUMENTS

Request for Withdrawal of Finality of Rejection

The present office action, mailed January 10, 2005, was issued in response to a preliminary amendment that accompanied a request for continued examination (RCE). The present office action was thus made final on first action. No rationale was provided for why the action was made final.

Applicant submits that an action, such as the present one, that is issued immediately subsequent to the filing of an RCE may be made final only if the conditions set forth in MPEP §706.07(b) are met. That section of the MPEP specifies conditions where a first action final rejection may be made in continuation applications. Those conditions stipulate that a first action final rejection is proper where *all* of the claims of the new application (in this case, the RCE application) would have been properly finally rejected (had those claims been in the earlier application) on “the grounds and art of record.” In other words, a first action final rejection is proper only if the RCE claims can be properly rejected on the same grounds as applied in the earlier application.

In the earlier application, the form or dependent claim 57 was objected to, but was otherwise deemed allowable. That claim 57 stated that, with respect to the attachment means:

“the attachment means comprise a plurality of holes formed in the chassis of the support module and the room module, the holes being alignable to receive therethrough a locking bolt to secure the room module to the support module.”

Applicant included in the RCE application (via the preliminary amendment noted above) a new claim 87, as follows:

“87. (new) A building structure according to Claim 71, wherein the attachment mechanisms comprise a plurality of holes formed in the support chassis of the support module and the room module, the holes being alignable to receive therethrough a locking bolt to secure the room module to the support module.”

The prior final office action, mailed March 24, 2004, that immediately preceded the filing of the RCE (hereafter, referred to as the “prior final office action”) found claim 57 patentable. Accordingly, it is readily apparent that there *were no grounds* and art of record applied in the prior

final office action that could be properly applied to reject claim 87 in the RCE application. For that reason alone, the finality of the rejection should be withdrawn because the conditions required under MPEP §706.07(b) have not been met.

Put another way, the first time the subject matter of claim 87 was rejected was in the present office action of January 10, 2005, which also designated this first rejection (improperly so) as a final rejection. Moreover, as respects claim 87, the grounds in the present office action were formulated differently from the grounds set forth in the prior final office action.¹ In particular, on page 2 of the present office action the rejection grounds were revised (as compared to the prior final office action) as follows:

"the chassis 52 having an attachment means with holes 70 shown in figures 4-6 ..."

The phrase "*with holes 70*" was inserted in the present office action to provide, for the first time, grounds for rejecting claim 87. This is further evidence that the grounds provided in the prior final office action could not, without substantive revision, have been used to reject claim 87 of the RCE application. (As discussed more below, the elements identified in the office action as "holes" are in fact rubber support members –quite incomparable to holes).

In view of the foregoing, applicant respectfully requests withdrawal of the premature final rejection, and entry of the amendments presented in this paper.

Restriction Requirement

Enclosed with this paper is a petition under 37 CFR § 1.181 from the final decision of the Examiner requiring restriction in this application. For the sake of efficiency, applicant below discusses the patentability of all claims presented in this amendment, irrespective of whether they were properly withdrawn by the Examiner.

Previously Filed Information Disclosure Statement

The RCE application papers included an information disclosure statement that cited to the Examiner US Patent No. 3,541,744 to Maxwell. Applicant notes that the Examiner mentions this reference in the present office action. Applicant thus asks that the next issued paper include an indication that this reference has indeed been considered.

¹ This is not surprising since the subject matter was allowed –not rejected- in the prior final action.

Patentability of the Claims as Amended in this Paper

Claims 71 – 73, 79, 84 – 90, 92 – 93² and 96 was rejected as anticipated by Sing, US Patent No. 4,766,708. In reply, applicant notes that each of these claims calls for cantilevered attachment of a room module to the support module. For example, in claim 71 the room module is, among other things, “*cantilevered from the support module.*” Applicant submits that the pertinent definition of the term “cantilever” (noun) means “a projecting structure, such as a beam, that is supported at only one end.”³ In the context of the present claims, therefore, applicant submits that the term “cantilevered” (verb) should be construed in its ordinary meaning such that a room module is supported at only one end by the support module. Such is clearly not the case in Sing.

Sing makes no disclosure of room modules that are independently attachable to and cantilevered from the support module. The “room” modules 42 identified in Sing are all supported by isolators 66 that are distributed across the entire area of the bottom of each room module, as can be clearly seen in, for example, Figs. 3 and 9 of Sing. Specifically, Sing points out that its living modules 42 are placed in the frame 22 (the frame being what the Examiner identifies as the claimed support module). A plurality of isolators 66 extend from the frame “to contact every exterior surface of unit 42.”⁴

Applicant submits that a fair reading of Sing shows that the notion of cantilevered modules 42 is not at all contemplated there. Accordingly, Sing does not anticipate independent claims 71 – 73, 79, 84 – 90, 92 – 93 and 96. As noted in MPEP § 2131: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).)

The foregoing comments about the failure of Sing to disclose room modules that are independently attachable to and cantilevered from the support module were made in the prior amendment provided by applicant. In the fifth paragraph on page 5 of the present office action the

² In this portion of the office action, it appears that method claim 93 has been examined on the merits, even though the preceding portion of the office action indicates claims 93 – 95 have been withdrawn.

³ Excerpted from *The American Heritage Dictionary of the English Language, Third Edition* Copyright © 1992 by Houghton Mifflin Company.

Examiner responds to applicant's earlier arguments but makes no mention as to applicant's point that Sing does not contemplate cantilevered room module attachment. Rather, the Examiner appears to respond with what might be considered as an obviousness rejection under 35 USC §103 by asserting that:

"Sing discloses the attachment mechanism as defined in Claim 71 and Maxwell shows the individual cantilevered rooms. The prior art provides a way to flexibly approach and precisely select the placement of room modules relative to the support module." (emphasis added)

For the sake of efficiency, applicant will treat the foregoing as an obviousness rejection and respond by pointing out that this rejection should be withdrawn for failure to state a proper *prima facie* case of obviousness. As set forth in the MPEP § 2143:

*"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."*

In the case at hand, no rationale has been provided in the present office action for modifying Sing to include cantilevered attachment of modules as shown in an embodiment of Maxwell. Accordingly, a *prima facie* case of obviousness has not been made.

In this regard, it is clear that Sing does not suggest cantilevered attachment of a room module to a support module. Cantilevered attachment of a room module to the support module removes the need for a supporting frame to be located around the room module itself, thus reducing the size, weight and cost of the supporting structure. It can clearly be seen from Fig. 1 that Sing

⁴ Col. 4, lines 40 – 42.

provides a sturdy supporting frame that surrounds the room modules and is required to support the room modules in the described manner.

Sing is directed to the provision of building structures that are resistant to substantial shocks arising, for example, from earthquakes. In such circumstances, supporting of the room modules as fully as possible (and not just at one end) would appear to be desirable, and it is submitted that a skilled person reading the disclosure of Sing would be positively discouraged from removing any support from the room modules to arrive at the claimed cantilevered room modules.

Applicant also points out that claims 71 and 96 also recite a support module having *attachment means* for attaching a room module to the support module. This claim limitation is written in means-plus-function format and, therefore, a proper rejection of this claim element requires a showing that an element in Sing performs the function specified. Moreover, the office action must provide an explanation and rationale as to why the identified Sing element is an equivalent to what is described in the application for performing that function. MPEP § 2183.

In the case at hand, the office action identifies "holes 70" as part of the structure in Sing that carries out the function of the claimed attachment means. In reply, applicant notes that the elements 70 in Sing are stabilizing members, preferably formed of hard rubber and sized so that during severe earthquakes they fall away from contact with the frame and surface of the unit 42.⁵ Accordingly, these rubber members are not an equivalent to anything described in the current application for carrying out the attachment means function of claims 71 and 96, and these claims are thus allowable.

Applicant notes that the mistaken assertion in the office action that items 70 in Sing are holes should be withdrawn and claim 87 (as well as the other claims relating to claim 71) should be allowed.

Method claim 93 includes the step of attaching each room module to the support module for support thereby in independent, cantilevered attachment. As explained in detail above with respect to claim 71, Sing does not teach or suggest such cantilevered attachment. Thus claim 93, like claim 71, is allowable over the art of record. Also, claim 93 recites in step-plus-function

⁵ Col 4, line 50 – Col. 5, line 19 of Sing.

format: “attaching each of the room modules at one of several positions of attachment by attaching the room module at one of several different locations along the chassis member of the support module.” Applicant submits that no element(s) equivalent to what is described in the current application has been identified in the prior art for performing this function. For this reason, too, claim 93 and its dependent claims 94 – 95 are allowable. MPEP § 2183.

New claim 97 further specifies that the attachment means of claim 71 further functions to lock together a room module and the support module. New claim 98 specifies that the attachment means of claim 71 further functions to bolt together a room module and support module.⁶ Such locking attachment is antithetical to Sing, which employs springy support of the room module, thereby to absorb vibration and permit unlocked movement of the room module relative to its supporting frame in the event of an earthquake.

Request for Interview

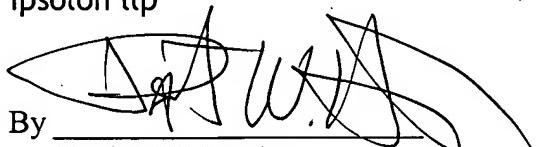
In order to facilitate prosecution of this application, applicant hereby requests a telephonic interview with the Examiner. The undersigned will soon contact the Examiner to arrange the interview.

Conclusion

In view of the foregoing, applicant submits that all of the present claims are in condition for allowance. If the Examiner has any questions, she is invited to contact applicant’s attorney at the below-listed telephone number.

Respectfully submitted,
ipsolon llp

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⁶ Support for these claims appears, for example, in the specification on page 12, last paragraph.